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*Amendment*  
*Attorney Docket No. S63.2B-10447-US01*

**Remarks**

This Amendment is in response to the Final Office Action dated **January 24, 2006**. In the Final Office Action claim 1 was rejected under 35 USC 112, first paragraph. Claims 1-2, 4-5, 7-10, 15, 34, and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Erbel. Claim 6 was rejected under 35 USC 103(a) as being unpatentable over Cox in view of Erbel and further in view of Barone (USPN 6,613,078). Claims 16-18, 22-24, and 26-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinsky in view of Erbel. Claim 25 was rejected under 35 USC 103(a) as being unpatentable over Wolinsky in view of Erbel and further in view of Thornton et al (USPN 6,551,350). Applicant will address the rejections under paragraph headings consistent with the numbering of the paragraphs in the Office Action.

**1-2**

In the Final Office Action claim 1 was rejected under 35 USC 112, first paragraph. Applicant disagrees with the rejection. Nevertheless, for purposes of expediting allowance of this application, claim 1 has been amended to recite "each curved region having a first end and a second end with a middle portion disposed substantially midway therebetween, the middle portions being substantially aligned with one another in a circumferential direction". No new matter has been added with this amendment.

**3-15**

Claims 1-2, 4-5, 7-10, 15, 34, and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cox (US 6,652,579) in view of Erbel et al (US 2004/0116998). Applicant disagrees with this rejection. Nevertheless claim 1 has been amended to recite "each curved region having a first end and a second end with a middle portion disposed substantially midway therebetween, the middle portions being substantially aligned with one another in a circumferential direction". Neither Cox nor Erbel teach or suggest this limitation individually or when combined.

The curved portions of the Cox are not substantially aligned; they appear to be displaced longitudinally by about 20% of the length of the curved portion.

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While Erbel teaches the use of a cover, it does not provide the missing limitation of "the middle portions being substantially aligned with one another in a circumferential direction". For at least this reason Applicant believes claim 1 and those claims dependent thereof are in condition for allowance. Applicant respectfully requests that the rejection be withdrawn.

Please note that in paragraph 5, the Office Action also states that "Cox discloses the stent in claim 16 and 17 as stated above". The Office Action does not give any specifics as to how Cox discloses the stent in claims 16 and 17. Nothing is "stated above" regarding Cox, so Applicant is at a loss to the basis for this rejection.

As detailed below, claim 16 has been amended and is believed to be in condition for allowance.

Claims 13 and 14 were rejected as product by process claims. However no process is actually being claimed; instead, the claims claim a medical device having a specific type of radiopaque marker. While the references and the claims teach a medical device having a radiopaque marker, the actual products in the claims are different in that they teach specific radiopaque markers as described in the claims. One of ordinary skill in the art at the time of the invention would recognize that radiopaque markers in the form of plated radiopaque material, coated radiopaque material, painted radiopaque material, swaged radiopaque material, or welded radiopaque material have different characteristics. These different radiopaque materials are included in the specification due to these different characteristics (e.g. thickness and porosity). As the products are not the same, Applicant respectfully requests that the rejection be withdrawn.

Claim 6 was rejected under 35 USC 103(a) as being unpatentable over Cox in view of Erbel and further in view of Barone (USPN 6,613,078). Claim 6 is believed to be in condition for allowance for at least the reason that it claims dependence on claim 1 which recites "each curved region having a first end and a second end with a middle portion disposed substantially midway therebetween, the middle portions being substantially aligned with one another in a circumferential direction". As asserted above, Cox, Erbel, or their combination do not teach or suggest this limitation. This missing limitation is not provided by Barone as Barone does not even suggest the use of radiopaque markers. Applicant requests that the rejection be

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withdrawn.

**16-23**

Claims 16-18, 22-24, and 26-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinsky in view of Erbel. Applicant disagrees with this rejection. Claim 16 has been amended to recite "the at least one connecting strut having a region with an enlarged width with a greater radiopacity than the remainder of the strut, the region disposed between two of the plurality of serpentine bands". Neither Wolinsky nor Erbel teach or suggest this limitation.

Instead, the radiopaque markers of Wolinsky are located on the serpentine band. Erbel does not provide this missing teaching. For at least this reason Applicant believes amended claim 16 is in condition for allowance. Applicant respectfully requests that the rejection be withdrawn.

Claim 26 has been amended to recite "circumferentially adjacent each side of each special strut are a plurality of interconnected struts having a curved region wherein the first side and the second side of each interconnected strut of the plurality are curved about the radiopaque marker". Wolinsky does not teach or suggest this limitation. The second adjacent struts of Wolinsky appear to have an inflection point rather than a curve. But even if, for the sake of argument only, the inflection point is viewed as a curve the strut does not have a curved region wherein the first side and the second side of the strut are curved about the radiopaque marker. For at least this reason claim 26 overcomes the rejection.

Additionally, Wolinsky does not show markers in the intermediate bands of the stent. Because of the configuration of the Wolinsky stent and, in particular, the shape of the markers and the presence of the many connectors between adjacent bands, one of ordinary skill in the art would not be expected to include the markers of Wolinsky in any other region of the Wolinsky stent other than the end-most serpentine bands. Erbel does not supply the motivation for any such modification. Therefore, claim 26 and claims 27-28 dependent therefrom are patentable over the proposed combination of Wolinsky and Erbel.

Applicant respectfully requests that the 103(a) rejection of claim 26 and claims 27-28 dependent thereof be withdrawn.

Regarding claim 22, the Office Action acknowledges that Wolinsky in view of

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Erbel does not disclose the size of the cover nor special struts located anywhere between the middle of the stent and a position one half of the way from the middle of the stent to an end of the stent. However the Office Action asserts it would be obvious to alter the size of the cover and thus the special struts having radiopaque markers could be located as recited in the claim. Applicant disagrees with this rejection.

Neither Wolinsky nor Erbel provide a suggestion or motivation for special struts disposed as recited in claim 22. Applicant believes the Office Action has rejected the claim through the use of hindsight. Such a rejection is impermissible. Without some stated suggestion or motivation, the rejection is inappropriate. Applicant believes none exists and as such believes claim 22 is in condition for allowance. Applicant respectfully requests that the rejection be withdrawn.

Claim 25 was rejected under 35 USC 103(a) as being unpatentable over Wolinsky in view of Erbel and further in view of Thornton et al (USPN 6,551,350). Claim 25 is believed to be in condition for allowance for at least the reason that it claims dependence on claim 16 which recites "each curved region having a first end and a second end with a middle portion disposed substantially midway therebetween, the middle portions being substantially aligned with one another in a circumferential direction". As asserted above, Wolinsky, Erbel, or their combination do not teach or suggest this limitation. This missing limitation is also not provided by Thornton. For at least this reason, claim 25 is believed to be in condition for allowance.

Applicant requests that the rejection of independent claims 16 and 26 and those claims dependent thereof be withdrawn.

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**Conclusion**

In light of the above comments, claims 1-2, 4-10, 13-18, 22-28, and 34-35 are believed to be in condition for allowance. Notification to that effect is respectfully requested.

Respectfully submitted,

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Date: March 24, 2006

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